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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20350 7590 06/30/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
RETTA, YIHDEGA				
ART UNIT		PAPER NUMBER		
3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/748,694

**Applicant(s)**

SCHOLL, NATHANIEL BLAKE

**Examiner**

Yehdega Retta

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 9-18, 20 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 9-18, 20 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/083)
- Paper No(s)/Mail Date 12/23/08, 1/13/09
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is in response to amendment filed March 19, 2009. Applicant amended claims 1, 2, 4, 5, 9-18, 20 and 24, and canceled claims 3, 6-8, 19, 21-23 and 32-35. Claims 1, 2, 4, 5, 9-18, 20, 24-31 are currently pending

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 now, recites receiving *search result data* relating to previously-executed searches that *each includes* a link to information for *the item in corresponding set of search result data*. It is unclear if the search result is received for each previously-executed search i.e., each previously executed search provide the same search result. It is also unclear if the “each” stands for the search result or the previously executed searches. If applicant intends to claim that the search result data includes a link to information for the item searched, it is unclear what is considered “*a corresponding set of search results*”. It is unclear if the corresponding set of search results is part of the search result data or addition search results. The claim also recites that the *search result data includes a link to* information for the item in a corresponding set of search results and the *search result data for each previously-executed search* indicating *at least* a search term and *placement of a link within the corresponding set of search results* provided for display and *whether the user selected the link for the item from the search result. How is it*

*that* the previously-executed search includes a placement of the link within the corresponding set of search result. Does applicant mean the search result include a link. Is applicant referring to the search result? (not the search request). It is also unclear what "whether the user selected the link" is refers to.

Applicant, in the preamble, indicates that the search request is related to an item. However the body of the claim does not indicate that the search is for the item, therefore it is how the search result and link is related to an item. There is no correlation between the item, the search and also the search result.

The claim also recites determining, based at least in part on the received search result data an extent to which users who entered the search term *subsequently selected the link to the item from the search results*. If each of the search result data includes a link to information for the item, then which link is considered "the link" since more than one link is include in the search result for each query. It is also unclear what is meant by determining "an extent to which users who entered the search term subsequently selected the link". Does it mean it is determined the likelihood the user selected one of the links or determining whether the user selected the link or not. It is also unclear how, by just receiving a search result data that includes links to information can be determined an extent to which someone selected a link. Examiner could not understand what applicant meant by "determining based at least in part on the received search result data an extent to which users who entered the search term subsequently selected the link to the item from the search results, the extent being a function of a frequency of selection of the item when the link is displayed and a page number on which the link was presented in the search

results, the extent being determined to be greater for a higher page number at the same frequency of selection”.

It is also unclear what applicant intended to claim by “upon receiving a subsequent search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the *extent* to which users selected the link to the item exceeds *calculated extents* for other items in the search results for the *subsequent search request*, independent of a page number of the search results on which the link for the item is configured to be displayed. It is unclear if the search result data for an item also includes other items in the search result. It is also unclear if the subsequent search request containing the search term refers to a follow up search request using the same search term, (i.e., after an initial search using the same term is executed).

Regarding claim 13, it is unclear what determining an *extent to which users selected* a link to an item presented in search results for previously-submitted queries including the search term and related to the item *when the link was included on a page other than* a first page of the search results, the extent being determined to be greater for a higher page number at a common frequency of selection. Does “determining an extent to which” means determining whether users selected the link or why the users selected the link or the number of times users selected the link? If the determining is whether users selected a link to an item presented in a page other than the first page, it is still unclear what “the extent being determined to be greater for a higher page number *at a common frequency of selection*” means.

Claim 24 also recites similar limitation, therefore is rejected for the same reason.

Dependent claims are also rejected since they inherit the rejected limitation of the independent claims.

***Claim Rejections - 35 USC § 102***

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 9-18, 20 and 24-31 are rejected under 35 U.S.C. 102(c) as being anticipated by Calabria et al. (US 2005/0137939 A1).

Regarding claims 1 and 4, 5, 9-12, Calabria teaches receiving search result data for searches that include a link for the item in its search result, the search result data for a search indicating a search term, placement of the link within the search result, and whether user selected the link for the item; determining based on the received search result data whether users who entered a certain search term subsequently selected the link to the item even though the link was not prominently placed in the search result; and when it is determined that users who entered a certain search term subsequently selected the link to the item even though the link was not prominently placed in the search result, indicating to place an advertisement for the item along with the search result for that certain search term wherein the advertisement is prominently placed along with the search result (see [0006]-[0017], [0021] - [0025], [0053]-[0057] sponsored links ranked based on click-through rate). *Calabria also teaches upon receiving a subsequent search request containing the search term, determining to place an advertisement for the item on the first page of the search result for each search request (see [0021]-[0024])*

Regarding claims 2, Calabria teaches wherein the link is not prominently placed in the search result when it is not placed on the first page of the search result; wherein the

advertisement is prominently placed along with the search result when it is placed on the first page of the search result ((see [0037], [0059], [0072], [0134])).

Regarding claims 13 and 24, Calabria teaches determining whether a user selected a link to the item when the link was included on a page other than the first page of a search result of a search using a search term; and when it is determined that a user selected a link to the item when the link was included, on a page other than the first page of a search result of a search using a search term, requesting an advertisement to be placed on the first page of a search result for a search using that search term. Calabria teaches advertisement (sponsored) ranked placed based on the amount that are willing to pay also based on click through (see [0021] – [0025], [0037] – [0042]).

Regarding claims 14 and 25, Calabria teaches search engine service provides the link of a search result without payment of an advertisement fee (search result are provided to the user without the user paying advertisement fee).

Examiner would like to point out that whether the search engine service provides the link with or without the payment does not affect the step of "determining whether a user selected a link" and the step of "requesting and advertisement to be placed". Since there is no additional step performed, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (fed. Cir. 1994).

Regarding claims 15-18, 20 and 26-31 Calabria teaches wherein a fee is paid for requesting payment of the advertisement; wherein the advertisement is paid for on a cost-per-selection basis. wherein the links are provided without charge to a vendor of the item and the

requested advertisement is paid for by the vendor on a cost-per-selection basis; wherein a fee paid for the advertisement associated with the search term is based on prominence of the placement of the link in the search result and number of selections of the link to the item of search results (see [0004] – [0012], [0019] – [0021]).

***Response to Arguments***

Applicant's arguments filed March 19, 2009 have been fully considered but they are not persuasive. Applicant argues that Calabria does not teach "receiving search result data relating to previously-executed searches that each included a link to information for the item in a corresponding set of search results" where the search result data for each previously-executed search indicates "at least a search term submitted by a user, placement of the link within the corresponding set of search results provided for display to the user, and whether the user selected the link for the item from the search results" as recited in Applicants' claim 1 as amended. Examiner respectfully disagrees. Calabria teaches user the method is related to key-word advertising associated with or found within a regular search results list generated, for example, by Internet search engine in response to a keyword query submitted by a user (see background [0001]). Calabria also teaches for example when a user searches for "deck plans" using a search engine such as Google or AltaVista in addition to the usual query result, the user will be shown a number of sponsored results (see [0003]-[0010]). Therefore, Calabria teaches search result data to user search query (previously-executed searches) including link to information for the item queried (in Google or AltaVista the search results provide link to information for the query item for example "deck plans"), whether the user selects any of the links in the search results.



Applicant also argues that *Calabria* does not disclose or suggest determining "an extent to which users who entered the search term subsequently selected the link to the item from the search results," where the extent is "a function of a frequency of selection of the item when the link is displayed and a page number on which the link was presented in the search results" as recited in claim 1. As indicated above it is unclear which link applicant is referring to, since each list in the search result includes a link to document related to the query item. It is also unclear what applicant is referring to the extents for other items in the search results for the subsequent search request since the search result only includes links to information for the item. There is also not correlation in the claim between the page and the search result, so it is unclear what "independent of a page number of the search results on which the link for the item is configured to be displayed" means. It short is unclear if the search result is displayed or is to be displayed in more than one page.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Archarya et al. (US 7,346,839 B2) teaches scoring document based on historical data and ranking the document.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622